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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,343	12/02/2003	G. W. Johnson III	ACTZ-P01-004	9005
28120 7590 11/14/2008 ROPES & GRAY LLP PATENT DOCKETING 39/41 ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624				
EXAMINER				
RICHMAN, GLENNE				
ART UNIT		PAPER NUMBER		
3764				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/726,343

**Applicant(s)**

JOHNSON, G. W.

**Examiner**

/Glenn Richman/

**Art Unit**

3764

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The rejection from the prior office action is maintained and incorporated herein by reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7, 13-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng.

Cheng discloses a substantially rigid structure fig. 6 said substantially rigid structure having an inner surface fig. 6 and an outer surface fig. 6, said substantially rigid structure having a plurality of holes 115 there through at pre-selected locations; a flexible support member comprising a top layer and a bottom layer 120 and a liner affixed to the flexible support member and adapted to be positioned next to the body portion 124, and wherein the flexible support member is positioned between the substantially rigid structure and the liner fig. 7.

Cheng further discloses said liner provides substantially uniform compression to the body part to prevent the occurrence of window edema col. 4, lines 41 – et seq, said flexible support member is provided with a plurality of holes therethrough 125, the

plurality of holes located in the flexible support member include a sealed interface between the top layer and the bottom layer of the flexible support member fig. 7, the liner covers at least one of the holes located in the flexible support member fig. 7, the liner covers at least one of the holes located in the substantially rigid structure fig. 7, the flexible support member is pre-inflated fig. 7, the top layer and the bottom layer of the flexible support member are sealable around their edges fig. 7, the flexible support member is reversibly attachable to the substantially rigid structure fig. 7, the liner is sealingly attached at its periphery to the periphery of the flexible support member fig. 6, a plurality of holes in the flexible support member are in alignment with a plurality of holes in the substantially rigid structure fig. 7, at least one of the plurality of holes in the substantially rigid structure has a smaller diameter than at least one of the plurality of holes in the flexible support member fig. 6 and 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of Darby.

Cheng does not disclose the various species of claims 3-5.

Darby discloses a prosthesis fig. 1, an orthosis fig. 1, said orthosis is selected from the group consisting of an ankle brace, a leg brace, a walking brace, and an arm brace fig. 1.

It would have been obvious to use these devices of Darby's with Cheng's device, as it is well known as taught by Darby, that edema needs to be prevented in these devices as well as in the shoe like device of Cheng.

Darby further discloses consisting of an air cell, a cell filled with a gel, a cell filled with a fluid, a solid gel material, a non-porous foam pad, and a porous foam pad abstract, an air cell and said air cell contains a foam material 0023, said flexible support material is a porous material 0034, said porous material is an open-cell foam 0024.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Glenn Richman/ whose telephone number is 571-272-4981. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571)272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenn Richman/  
Primary Examiner  
Art Unit 3764